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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,163	02/28/2001	Dorit Wolf	Wolf, D. Et Al-1 PCT	4075
25889	7590	03/05/2007		
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER KOSLOW, CAROL M	
			ART UNIT	PAPER NUMBER
			1755	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/786,163

Applicant(s)

WOLF ET AL.

Examiner

C. Melissa Koslow

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-15, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-15, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1755

This action is in response to applicants' amendment of 11 January 2007. The amendments to the claims have overcome the rejection over claims 3-15, 18 and claim 19 with respect to "Ka" and "organometallic catalysts". The amendments to the specification have overcome the objections with respect to "Ka", the first paragraph and page 2. Applicants' arguments with respect to the art rejection were convincing and thus it is withdrawn. Applicants' argument with respect to "pre-step probabilities" and thus the objections and rejections with respect to this are withdrawn. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

It is noted that the PCT and German applications still contain reference to non-existent element "Ka".

Applicant's claim for foreign priority under 35 U.S.C. 119(a) and 37 CFR 365(b) is acknowledged. However, the German application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claim 19 of this application. The subject matter of claim 18 is not found in the German priority document DE 19843242.9. With respect to the subject matter of claim 19, the German priority document contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the same reasons as this application, discussed below. Thus it does not meet under 35 U.S.C. 112, first paragraph and accordingly applicants are not entitled to the filing date of German priority document DE 19843242.9.

The disclosure is objected to because of the following informalities:

Art Unit: 1755

The process of step d is indefinite since it is unclear how the probabilities W_{cat} , W_A , W_B , W_D and W_t actually relate to the determination of the compositions of formula I in each n_{th} generation. The x variables in tables 4 and 6 are not defined. If x has the same meaning as p, which 0-0.75, then there is a question if these materials have the given formula since catalyst have a neutral valence state and those disclosed are not neutral since the maximum molar amount of oxygen is 0.75. The compositions in tables 5, 7 and 8 do not contain oxygen and thus are not those of tables 4 and 6. The process on page 18 would lead one of ordinary skill in the art to expect the catalyst of tables 5, 7 and 8 to be oxides, but this is not indicated by these tables. Appropriate correction is required.

Applicants arguments with respect to the probabilities are noted but they do not address the objections since there is no relationship between the probabilities and the determination of the composition of formula I in each n_{th} generation. In addition, the argument the mathematical expressions for defining the probabilities W_{cat} , W_A , W_B , W_D and W_t means they are all the same is not found in the specification. there is no indication in the specification that probabilities W_{cat} , W_A , W_B , W_D and W_t are all equal or the same. Applicants' arguments with respect to x is not convincing since the determination of a catalyst composition, including the amount of oxygen, is the purpose of the claimed invention. Applicants' argue it is conventional in the catalyst art not to define the amount of oxygen in catalyst composition but have not present any evidence to support this assertion. The objections are maintained.

Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

Art Unit: 1755

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended step a of claim 19 is new matter. The specification teaches the first generation of catalyst is prepared from primary components which are already known to be catalytic or which are known to form catalysts and this catalyst is introduced into a substance library. Thus it is the prepared catalyst compounds of formula (I) which is introducing into a substance library. Claimed step a teaches forming a substance library by selected and introducing known catalytic compounds into the library and then forming a catalyst from the compounds selected from a substance library. The amendment changing "pre-set" to "the same" is new matter since there is nothing in the original disclosure teaching the pre-set probabilities are all the same.

The amendment did not overcome the rejection. Thus it is maintained.

Claims 3-15, 19 and 20 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For one of ordinary skill in the art to perform step a in this claim, undue experimentation would be required since the catalyst art is an unpredictable art and one would have to test each and every embodiment of formula I, except for those already known, in order to determine if the resulting compound is a catalyst or not. In addition there is no criteria given to limit the millions of possible compounds that result from formula I to 5 to 100,000 compounds.

Applicants' arguments are not convincing since step a and claims 10-15 require experimentally determining the fitness of obtained materials, i.e. actually testing each obtained

Art Unit: 1755

catalyst in a catalytic reaction. This means each of the millions of possible compounds that result from formula I must be tested. Since the catalytic art is unpredictable, one of ordinary skill in the art could not predict if a compound resulting from reacting two catalytic materials together would also be catalytic for the same reaction.

Claims 3-15, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for producing hydrogenation catalysts does not reasonably provide enablement for producing any and all inorganic and organometallic catalyst. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicants did not address this rejection and the amendment did not overcome it.

Claims 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The process of step c in claims 19 and 20 is indefinite since it is unclear how the probabilities W_{cat} , W_A , W_B , W_D and W_t actually relate to the determination of the compositions of formula I in each n_{th} generation.

Claims 19 and 20 are identical. Applicant is advised that should claim 19 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Art Unit: 1755

The wording of lines 2-8 of step a in claims 19 and 20 is confusing as written. For example, applicants uses the term “material” and “element” interchangeably, but element and material in the rest of the claims have different meanings. Applicants should delete the phrases “have already been described or ” and “or have been determined empirically or intuitively” since catalytic materials known for the desired catalytic reaction step must have already been described or have been determined empirically or intuitively, otherwise they would not be known.

Claim 3 is indefinite since there is no step (j) in claim 19.

Claim 9 teaches the catalyst mixtures are produced from salts of A and optionally salts of B and D and/or supports T. These salts and supports do not meet the requirement of step a since they are not catalytic materials known for the desired catalytic reaction.

The arguments with respect to the rejections with respect to the probabilities are not convincing for the reasons given above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1755

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
March 2, 2007


C. Melissa Koslow
Primary Examiner
Tech. Center 1700